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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/387,696	08/31/1999	GEORGE GOICOECHEA	BSI-212	2901

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EXAMINER

BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/387,696	Applicant(s) GOICOECHEA ET AL.	
	Examiner Javier G. Blanco	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/16/2004; 12/15/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-61 is/are pending in the application.
- 4a) Of the above claim(s) 55, 56 and 59-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 54, 57, and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/16/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicants' amendment of independent claims 54 and 57 in the reply filed on December 15, 2003 is acknowledged.

Election/Restrictions

2. Applicants' election without traverse of **Tubular axis of prosthesis**: Species A (single tube), and **Tubular prosthesis**: Species A (embodied in claims 54 and 57) in the reply filed on August 16, 2004 is acknowledged.
3. Claims 55, 56, and 59-61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 16, 2004.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 54 and 57 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Song (WO 92/06734 A1).

As seen in Figures 1-3 and 6, Song discloses a tubular prosthesis being axially divided into two or more hoop-like tubular portions (unit structures 11, 12, 13, and 14, or, unit structures

Art Unit: 3738

21, 22, 23, and 24) formed from corrugated portions of two or more wires or filaments (each unit structure is described as a wire “formed into a closed zig zag configuration thereby forming a series of straight sections 111 and bends 112”; see Figure 1; see page 5, lines 17-23) and connected by straightened extension portions (connecting members 31, 33, 35, and 37; see Figures 2 and 3; see page 6, lines 2-7) that could be placed diagonally (skew or in a helical path) along the longitudinal axis of the tubular prosthesis (see Figures 2 and 3; see page 6, lines 7-12).

Response to Arguments

6. Applicants’ arguments filed December 15, 2003 have been fully considered but they are not persuasive. With regards to claims 54 and 57, the Applicants argue that Song “fails to disclose a structure in which wires or filaments each have one or more corrugated portions”. The Examiner respectfully disagrees. As previously indicated in the 102(b) rejection, the two or more hoop-like tubular portions disclosed by Song are formed from corrugated portions of two or more wires or filaments (each unit structure is described as a wire “formed into a closed zig zag configuration thereby forming a series of straight sections 111 and bends 112”; see Figure 1; see page 5, lines 17-23). Song clearly teaches said subject matter (see Figures 1-3 and 6).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Song (WO 92/06734 A1) in view of Dereume et al. (US 5,639,278; cited in Applicants' IDS).

Song et al. discloses the invention as claimed except for particularly disclosing his/her endovascular prosthesis as a forked prosthesis comprising a generally tubular main branch and at least two secondary branches extending from said main branch. However, this is already known in the art, and it depends on the intended use. For example, Dereume et al. disclose (see Figures 20-28) a forked prosthesis comprising a generally tubular main branch and at least two secondary branches extending from said main branch in order to treat a condition in a bifurcated body vessel location (see Abstract; see entire document). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have combined the teaching of a forked prosthesis comprising a generally tubular main branch and at least two secondary branches extending from said main branch, as taught by Dereume et al., with the tubular prosthesis of Song, in order to treat a condition in a bifurcated body vessel location.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3738


CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:30 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

June 23, 2006

A large, stylized handwritten signature in black ink, consisting of a large 'J' and 'B' intertwined.A handwritten signature in black ink, appearing to read 'David H. Willse'.

David H. Willse
Primary Examiner